

REMARKS

Applicant respectfully requests reconsideration of the instant application in view of the amendments, herein, and the following remarks:

The following claims are *pending*: 1, 2, 6-9, 11-20 and 24-27.

The following claims are *independent*: 1, 16 and 20.

The following claims have previously been *cancelled* without prejudice or disclaimer: 3-5, 10 and 21-23.

Please *add new* claims 28 and please *amend* claims 1, 14, 16 and 20. Although these claims have been amended herein to provide clarification, correct typographical inaccuracies and/or informalities, and/or to better track practical/commercial implementations/practices, Applicant submits that the originally filed claims are patentable and reserves the right to pursue the originally filed claims (as well as any claims dependent therefrom) at a later time and/or in one or more continuation/divisional application(s). Applicant submits that these new claims and/or claim amendments are supported throughout the originally filed specification and that no new matter has been added by way of these amendments.

Claim Rejections - 35 U.S.C. § 101

The Office Action rejected claims 1, 2, 6-9, 11-20 and 24-27 under 35 U.S.C. § 101 as directed to non-statutory subject matter. Applicant respectfully traverses this rejection. The Applicant notes examples of specific types of values in the instant application at paragraph [0045] and actual values that may be used,

The risk assessment factor 116 assigned to the court may be a numerical value of 8 indicating a high risk with a weight of 10 given to court positions. In

addition, the subject matter may also be rated at an 8 because of the risk associated with the political climate and political climate may have a weight of 7 according to its location and breadth of coverage. On the other hand, the client may have strong evidence in support of their position, which may receive a 1 because it is a relatively low risk. Evidence may also have a risk factor value of 10. Also, the subject matter of the legal action may not be a core interest to the client wherein this risk factor may be assigned a value of 3, with interest to client having an assigned weight of 5. Therefore, the net score for this example would be 8 times 10 or 80 plus 8 times 7 or 56 plus 3 times 10 or 30 plus 3 times 5 or 15 for a sum of 181, which is the Risk Quotient.

(Application Serial No. 09/825,470, Pub. No. 2002/0143562 para. [0046]).

The Examiner is in error because those using the same types of values as in paragraph [0046] quoted above, will produce the same repeatable results. Just because the invention contemplates flexibly allowing users to establish scales that make sense for their application does not render the results random or unpredictable. Further, users are free to employ the example 1-10 scale described in paragraph [0046] quoted above and obtain the same repeatable results when the same inputs are used. In light of this, Applicant respectfully requests reconsideration and withdrawal of this basis of rejection and allowance of the claims.

Claim Rejections - 35 U.S.C. § 112

Claims 1, 2, 6-9, 11-20 and 24-27 have been rejected under 35 U.S.C. § 112, 1st paragraph as allegedly failing to comply with the enablement requirement. Specifically, the pending rejection alleges that “[t]he claim(s) contains subject matter which was not described in the specification in such a way as to enable one skilled in the art to which it pertains, or with which it is most nearly connected, to make and/or use the invention ” (Office Action, p. 2). Applicant respectfully traverses this rejection and submits that the Examiner has not put forth a *prima facie* case of lack of enablement. Applicant has amended these claims .

Accordingly, applicant requests: withdrawal of this ground of rejection(s), and reconsideration and allowance of the claims.

Claim Rejections - 35 U.S.C. § 103

The Office Action rejected claims 1-2, 6-9, 11-20 and 24-27 under 35 U.S.C. § 103(a) as being unpatentable over Heckman, et al., US Patent No. 5,875,431 (hereinafter “Heckman”), and in further view of Halligan et al., US Patent Pub. No. 2002/0077941 (hereinafter “Halligan”). Applicant respectfully traverses the rejections and submits that a *prima facie* showing of obviousness has not been made and that the applied references, taken alone or in combination, fail to discuss or render obvious every element of each pending claim.

MPEP § 706.02(j) prescribes that a rejection under 35 U.S.C. § 103 should set forth:

- (i) the relevant teachings of the prior art relied upon,
- (ii) the differences in the claim over the applied references,
- (iii) the proposed modification of the applied references to arrive at the claimed subject matter, and
- (iv) an explanation as to why the claimed invention would have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicants respectfully submit that the Examiner has failed to establish at least the first two requirements for a *prima facie* case of obviousness - the relevant teachings of the prior art relied on and the differences in the claims over the applied references.

Independent claim 1 recites *inter alia*:

receiving, into the computer memory of the computer, information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors and wherein the risk assessment factors are selected from a group including: a likelihood of prolonged litigation, damages, punitive damages, and damaged public opinion;

Applicants submit that the cited references do not discuss or render obvious at least these elements of independent claim 1.

The Examiner states that Heckman, discusses "receiving, into a computer memory of the computer, information relating to a plurality of risk assessment factors associated with legal actions (col. 6, lines 45-64D)]" (Office Action, page 10).

However, the Examiner admits that "Heckman does not disclose assigning a numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors, assigning a weight to each of the plurality of risk assessment factors, calculating a risk factor value by multiplying the numerical value and the weight assigned to each of the risk assessment factors; calculating a risk quotient for the legal action by summing the plurality of risk values." (Office Action, page 11).

Instead, the Examiner relies on Halligan and states that Halligan discusses a

trade secret documentation tool used to prepare reports and court exhibits documenting employee and outsider exposure to trade secrets so as to be used at the time of litigation by assigning a numerical value to each of a plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors (*Figure 4 Enter values of the five*

*factors for the Trade Secret, page 2 [0020-0023], page 6 [0094-0095], page 7 [0096] steps of applying a plurality of generally accepted legal criteria to the content of a trade secret, **assigning a value under each criterion**; applying generally accepted legal criteria (e.g. the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts; page 2 [0020-0023], page 6 [0095], and page 7 [0096-0098]*

(Office Action, pages 11-12 emphasis in Office Action).

Instead of the Examiner's alleged "numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors," (Office Action page 11, emphasis added). Halligan actually discusses that its "accounting system may calculate various weightings of the six factors for each trade secret to provide information to the accounting system's users on the protectability and other features of the trade secret." (Halligan, page 6 para. [0095], emphasis added). Halligan discusses its method with respect to the protectability of trade secrets and not a legal action. Combining it with Heckman still does not provide the claimed ". . . information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors. . . ." as recited by amended independent claim 1.

More specifically, Halligan discusses that "verifying a status of the trade secret as a protectable interest means applying generally accepted legal criteria (e.g., the six factors of a trade secret as set forth in Section 757 of the First Restatement of Torts) to the trade secret, assigning a value under each criterion and generating one or more metrics ("defendability factors") from the assigned values through the use of logical and

mathematical processes, thereby allowing the comparison of results with predetermined threshold values. Comparing the results with predetermined threshold values may be used to provide an objective measure of whether the trade secret is defensible (i.e., defensible)." (Halligan, page 7 para. [1196]). Applicants submit Halligan's various purchase currencies are different from the claimed ". . . information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors. . . ." as recited by amended independent claim 1. Further, Applicants submit the evaluation of the protectability or defendability is an assessment of the trade secret and not a legal action. There is no expectation of success in combining the references as Heckman accepts information regarding prior litigations and makes assessments based on such prior entries. "[T]he strategic planning system and process of this invention is an iterative system and process, whereby the ability of the system and process to provide the 'best' legal strategic plan to achieve a desired outcome is enhanced as completed cases are analyzed." (Heckman, col. 6, lines 13-17) and as such is structurally incapable of integrating with a trade secret system having no concept of litigation analysis. Applicants submit Halligan's discussion of analysis of the protectability of trade secrets does not render obvious the claimed elements. Should the Examiner disagree, Applicants respectfully request further clarification as to how Halligan's trade secret analysis allegedly renders obvious the claimed elements as recited by amended independent claim 1.

Therefore, Applicants further submit that Halligan fails to remedy the deficiencies identified above in Heckman with regard to independent claim 1. Instead of the claimed ". . . information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors. . . ." of claim 1, Halligan discusses an "accounting system may calculate various weightings of the six factors for each trade secret to provide information to the accounting system's users on the protectability and other features of the trade secret." (Halligan, page 6 para. [0095]). As such, Applicants submit Halligan does not remedy the deficiencies in Heckman discussed above or render obvious the claimed elements. Should the Examiner disagree, Applicants respectfully request further clarification as to how Halligan's protectability of trade secrets analysis allegedly renders obvious the features explicitly recited in independent claim 1.

Applicant submits that the pending rejection has not provided sufficient objective rationale for modifying the applied references. By way of example only, Applicant notes that the pending rejection alleges,

it would have been obvious to one of ordinary skill in the art at the time of the invention to combine analysis method and system of Halligan with the legal strategic analysis method of Heckman so that an evaluation can be performed to determine whether the trade secret is likely to meet the tests applied by the courts and comparing results with predetermined threshold values which can be used to provide an objective measure of whether the trade secret is defensible, and thus any alleged misappropriation should be litigated if the defensibility factors are high which may suggest a very important or defensible trade secret as opposed to trade secrets with low defensibility factors.

(Office Action, p. 13).

Applicant respectfully submits that the alleged rationales for the proposed modifications of the applied references provided here and throughout the pending rejection are overly general and comprise no more than stated goals of trade secret analysis which, by themselves, do not point beyond Halligan to a modification of itself or a combination with Heckman. Applicant is unclear how the Examiner believes the general alleged utility stated in Halligan, “trade secret analysis” would allegedly render the specific claims recited in the instant application as obvious to one of ordinary skill in the art. Applicant submits that merely citing an alleged utility of a reference’s own system, without providing any attendant explanation or articulation of how that alleged utility points beyond the reference to the modifications of the references proposed in the pending rejection, is insufficient to support an assertion of obviousness under 35 U.S.C. § 103. MPEP §2141 (III) states, *inter alia*, “The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious,” and that, “there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” Applicant submits that, by merely quoting alleged rationales of the applied references, the pending rejection has failed to provide a “clear articulation of the reason(s)” or an “articulated reasoning with some rational underpinning” for the proposed modifications of the references. Therefore, Applicant submits that a *prima facie* showing of obviousness has not been made and respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully requests precise clarification as to how the Examiner believes the cited objects of Halligan such as, “trade secret analysis,” allegedly point to the specific modifications of the applied references that are proposed by the

pending rejection. Applicant further requests that the Examiner clarify exactly why he believes the specific modifications, taken in relation to the claims as wholes, would allegedly have been obvious to one of ordinary skill in the art at the time the invention was made.

Applicant submits that the pending rejection has provided no indication of the level of ordinary skill in the art. MPEP § 2141 (II)(C) states, “Any obviousness rejection should include, either explicitly or implicitly in view of the prior art applied, an indication of the level of ordinary skill.” The pending rejection refers to, “one of ordinary skill in the art,” (e.g., Office Action, p. 13) but has provided no indication or discussion of which art is described or the level of ordinary skill alleged to be associated therewith. The rejection’s reference to “the art” is overly general and, consequently, does not provide a specific indication of the level of ordinary skill pertinent to the claimed subject matter. MPEP § 2141.03 (III) states, “The importance of resolving the level of ordinary skill in the art lies in the necessity of maintaining objectivity in the obviousness inquiry.” Applicant submits that objectivity has not been maintained and that impermissible hindsight has been applied in asserting obviousness of the various claim elements without providing an indication of the level of ordinary skill. As such, Applicant submits that a *prima facie* showing of obviousness has not been made and respectfully requests reconsideration and withdrawal of this basis of rejections. Should the Examiner maintain the rejection, Applicant respectfully requests that he discuss the level of ordinary skill in the art at the time of the invention and clarify how and specifically why he believes the claimed subject matter would have been obvious to one possessing that level of skill.

Although of different scope than claim 1, Applicants submit that claim 16 is patentable over Heckman in view of Halligan, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. For example, independent claim 16 recites, *inter alia*, "... information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors. . . ." Applicants respectfully submit that at least these claim elements from independent claim 16 are not discussed or rendered obvious by Heckman or Halligan taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Although of different scope than claim 1, Applicants submit that claim 20 is patentable over Heckman in view of Halligan, taken alone or in combination, for at least similar reasons as discussed above identifying deficiencies in the applied references with regard to independent claim 1. For example, independent claim 20 recites, *inter alia*, "... information relating to a plurality of risk assessment factors associated with the legal action, wherein a user-defined numerical value is assigned to each of the plurality of risk assessment factors, wherein the numerical value is indicative of a legal risk of each risk assessment factor relative to the other plurality of risk assessment factors. . . ." Applicants respectfully submit that at least these claim elements from independent claim 20 are not discussed or rendered obvious by Heckman or Halligan taken alone or in combination. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

Furthermore, Applicants submit that claims 2, 6-9, 11-19 and 24-27 which depend directly or indirectly from independent claims 1, 16 and 20 are also not discussed or rendered obvious by Heckman or Halligan taken alone or in combination, for at least similar reasons as those discussed above identifying deficiencies in the applied references with regard to the independent claims. Accordingly, Applicants respectfully request reconsideration and withdrawal of this basis of rejection.

CONCLUSION

Consequently, the reference(s) cited by the office action do not result in the claimed invention, there was/is no motivation, basis and/or rationale for such a combination of references (i.e., cited references do not teach, read on, suggest, or result in the claimed invention(s)), and the claimed inventions are not admitted to be prior art. Thus, the Applicant respectfully submits that the supporting remarks and claimed inventions, claims 1, 2, 6-9, 11-20 and 24-27, all: overcome all rejections and/or objections as noted in the office action, are patentable over and discriminated from the cited reference(s), and are in a condition for allowance. Furthermore, Applicant believes that the above remarks, which distinguish the claims over the cited reference(s), pertained only to noted claim element portions. These remarks are believed to be sufficient to overcome the prior art. While many other claim elements and/or bases for rejection were not discussed as they have been rendered moot based on the above amendments and/or remarks, Applicant asserts that all such remaining and not discussed claim elements and/or bases for rejection, all, also are distinguished over the prior art and reserves the opportunity to more particularly traverse, remark and distinguish over any such remaining claim elements and/or bases for rejection at a later time, should it become necessary. Further, any remarks that were made in response to an Office Action objection and/or rejection as to any one claim element, and which may have been re-asserted as applying to another Office Action objection and/or rejection as to any other claim element(s), any such re-assertion of remarks is not meant to imply that there is commonality about the structure, functionality, means, operation, and/or scope of any of the claim elements, and no such commonality is admitted as a consequence of any such re-assertion of remarks. As such, Applicant does not concede that any claim elements have been anticipated

and/or rendered obvious by any of the cited reference(s). Accordingly, Applicant respectfully requests reconsideration and withdrawal of the rejection(s) and/or objection(s), and allowance of all claims.

Authorization

Applicant hereby authorizes and requests that the Commissioner charge any additional fees that may be required for consideration of this and/or any accompanying and/or necessary papers to Deposit Account No. 03-1240, Order No. 17209_451. In the event that an extension of time is required (or which may be required in addition to that requested in a petition for an extension of time), Applicant requests that the Commissioner grant a petition for an extension of time required to make this response timely, and, Applicant hereby authorizes and requests that the Commissioner charge any fee or credit any overpayment for such an extension of time to Deposit Account No. 03-1240, Order No. 17209_451.

In the event that a telephone conference would facilitate examination of the application in any way, Applicant invites the Examiner to contact the undersigned at the number provided.

Respectfully submitted,
CHADBOURNE & PARKE LLP

Dated: October 27, 2009

By: Walter G. Hanchuk/
Walter G. Hanchuk
Registration No.: 35,179

Correspondence Address:

CHADBOURNE & PARKE LLP
30 Rockefeller Plaza
New York, NY 10112

212-408-5100 (Telephone)
212-541-5369 (Facsimile)
patents@chadbourne.com (E-mail)